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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/773,258	02/09/2004	Valerie de la Poterie	05725.0598-01	7152

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EXAMINER
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CHANNAVAJALA, LAKSHMI SARADA

ART UNIT	PAPER NUMBER
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1615

DATE MAILED: 08/04/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

10/773,258

Applicant(s)

POTERIE ET AL.

Examiner

Lakshmi S. Channavajjala

Art Unit

1615

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --****Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 10 May 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-31 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-31 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |   |   |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                        | 4) <input type="checkbox"/> Interview Summary (PTO-413)                     |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)    | Paper No(s)/Mail Date. _____  |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date _____   | 6) <input type="checkbox"/> Other: _____                                    |

### **DETAILED ACTION**

Receipt of response and terminal disclaimer dated 5-10-06 is acknowledged.

Claims 1-31 are pending.

#### ***Terminal Disclaimer***

The terminal disclaimer filed on 5-10-06 disclaiming the terminal portion of any patent granted on this application, which would extend beyond the expiration date of US Patent No. 6,361,782 has been reviewed and is accepted. The terminal disclaimer has been recorded.

In view of the terminal disclaimer, the following rejection has been withdrawn:

Claims 1-31 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-21 of U.S. Patent No. 6,361,782.

The following rejection of record has been maintained:

#### ***Claim Rejections - 35 USC § 102***

1. Claims 1-14 and 21-27 are rejected under 35 U.S.C. 102(e) as being anticipated by US 6,361,782 ('782).

Instant claims are directed to a mascara composition comprising a surface stabilized polymer particles dispersed in a fatty liquid phase.

Art Unit: 1615

'782 disclose a cosmetic composition comprising a surface stabilized polymer dispersed in a liquid fatty phase and teach the same polymers and fatty materials for preparing the dispersion (col. 6, col. 7, line 1-18). '782 disclose greater than 2% by weight of the polymers (col. 3, lines 55-67), so as to form a film and trap cosmetic additives such as dyestuffs. Instant claims recite at least 2% polymer concentration, which encompasses percentages above 2% of '782 and for the same "film-forming" purposes. '782 also describe the same stabilizers that are claimed in the instant applications (col. 9, lines 60 through col. 11). '782 also disclose the claimed animal, vegetable and mineral oils (col. 7, lines 52-col. 8, lines 20) and volatile oils such as isododecane. '782 also discloses anhydrous composition, with the claimed additives such as dyestuffs, fillers etc., and the composition for the same use i.e., for caring hands, face etc (col. 14). With respect to the claimed viscosity and solubility parameters, the composition of '782 involves the same polymers, stabilizers, additives, solvents etc., and in the same percentages and hence the viscosity and solubility are inherent to the composition of '782.

2. Claims 1-16 and 21-27 are rejected under 35 U.S.C. 102(e) as being anticipated by US 5,851,517 to Mougin et al ('517).

'517 disclose a cosmetic composition comprising a surface stabilized polymer dispersed in a liquid fatty phase and teaches the same polymers, stabilizers and fatty materials for preparing the dispersion (col. 1 and col. 4-5). '517 disclose the solubility parameters of the composition that read on the instant claimed solubility (col. 3, lines 7-

Art Unit: 1615

35). '517 disclose the claimed animal, vegetable and mineral oils (cols. 3 and 5) and volatile oils such as isododecane. '517 also disclose claimed additives such as dyestuffs, fillers etc., and the composition for the same use i.e., for hair and eyelashes etc (col. 6). With respect to the amount of the polymer, '517 disclose greater than 2% polymers (examples) and thus meet the claimed limitation. With respect to the claimed viscosity the composition of '517 involves the same polymers, stabilizers, additives, solvents etc., and in the same percentages and hence the viscosity is inherent to the composition of '517.

3. Claims 1-17 and 21-31 are rejected under 35 U.S.C. 102(e) as being anticipated by US 5,945,095 to Mougin et al ('095).

'095 disclose a cosmetic composition for make-up, including mascara, comprising a dispersion of a surface-stabilized polymer particles and a fatty substance (col. 10). The surface-stabilized polymers include those in the instant claims (col. 4, col. 7), and the liquid fatty substances include the claimed oils, fatty acid esters, silicone oils etc (lines bridging cols. 4-5), comprising the same solubility parameters as that claimed (col. 5). With respect to the claimed amount of the polymer, examples of '095 recite an amount that is above 2% of the total weight of the composition. '095 further teach the claimed additives in their composition and also anhydrous compositions (examples). With respect to the claimed viscosity the composition of '095 involves the same polymers, stabilizers, additives, solvents etc., and in the same percentages and hence the viscosity is inherent to the composition of '517.

***Claim Rejections - 35 USC § 103***

4. Claims 17-20 and 28-31 are rejected under 35 U.S.C. 103(a) as being unpatentable over US 5,851,517 to Mougín et al ('517).

'517 discussed above fail to exemplify the claimed fatty acid esters, fatty alcohols, silicone oils of the instant claims, and also fail to exemplify the compositions for the method of coating keratin fibers and eyelashes. However, '517 teaches the claimed fatty acids, fatty alcohols and silicon oils as suitable ingredients in the fatty phase (col. 9). Therefore, It would have been obvious for one of an ordinary skill in the art at the time of the instant invention was made to choose the claimed fatty esters, alcohol and specific silicone oils in preparing the composition of because '517 teaches all of the above fatty esters as equivalent in their solubilizing efficacy and compatibility with the surface-stabilized polymer (col. 7). Further, '517 also teaches application of the compositions in the field of hair, more particularly make up of eyelashes, the composition in the form of mascara (col. 6, lines 55-59). Accordingly, it would have been obvious for one of an ordinary skill in the art at the time of the instant invention was made to use the composition of '517 for the make up of eyelashes, in the form of mascara because '517 suggests that the preferable application of the composition is the field of hair products and eye make up products. And the expected result is a mascara composition wherein the polymer particles remain stable in the dispersion without aggregation.

Art Unit: 1615

5        Claims 18-20 are rejected under 35 U.S.C. 103(a) as being unpatentable over US 5,945,095 to Mougín et al ('095).

'095 discussed above fail to exemplify the claimed fatty acid esters, fatty alcohols, silicone oils of the instant claims. However, '095 teach the claimed fatty acids, fatty alcohols and silicon oils as suitable ingredients in the fatty phase (col. 7-9). Therefore, It would have been obvious for one of an ordinary skill in the art at the time of the instant invention to choose the claimed fatty esters, alcohol and specific silicone oils in preparing the composition of because '095 teaches all of the above fatty esters as equivalent in their solubilizing efficacy and compatibility with the surface-stabilized polymer (col. 7).

6.        Claims 1-31 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-47 of U.S. Patent No. 5,945,095.

Although the conflicting claims are not identical, they are not patentably distinct from each other because the patented claims and the instant claims recite a cosmetic composition comprising at least one fatty substance and a non-aqueous dispersion of surface-stabilized polymer particles in at least one liquid fatty substance, wherein the polymer particles being surface stabilized by surface-stabilizing polymer. Patented claims are also directed to a mascara composition (see claim 22). Patented claims do not specifically mention the limitations such as specific weight percentages, viscosity of

Art Unit: 1615

the polymer of the instant claims. However, the patent uses the same polymers for dispersion, stabilization and mentions the viscosity of 3-30 Pa.S (see patented claim 42). Accordingly, it would have been obvious for one of an ordinary skill in the art at the time of the instant invention was made to optimize the amounts of the polymers so as to arrive at the claimed viscosity of the composition to achieve the desired cosmetic effect i.e., a mascara composition.

### ***Response to Arguments***

Applicant's arguments filed 5-10-06 have been fully considered but they are not persuasive.

Applicants traverse the anticipation rejections over US patents 6,361,782 ('782), 5,851,517 ('517) and 5,945,095 ('095).

In response to applicant's argument that the US 6,361,782 ('782) fails to teach mascara, a recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. In the instant case, '782 disclose the same composition as that claimed in the instant, and is therefore capable of performing the functions of mascara. If the prior art structure is capable of performing the intended use, then it meets the claim. A preamble is generally not accorded any patentable weight where it merely recites the purpose of a process or the intended use of a structure, and where the body of the claim does not depend on the preamble for completeness but, instead, the process steps or structural limitations are able to stand



Art Unit: 1615

alone. See *In re Hirao*, 535 F.2d 67, 190 USPQ 15 (CCPA 1976) and *Kropa v. Robie*, 187 F.2d 150, 152, 88 USPQ 478, 481 (CCPA 1951).

Applicants argue that '095 and '517 are silent with respect to the ability to withstand rubbing under dry and wet conditions. Applicants also argue that none of the references teach a composition with the claimed viscosity. Applicants' arguments are not persuasive because, where the claimed and prior art products are identical or substantially identical in structure or composition, or are produced by identical or substantially identical processes; a prima facie case of either anticipation or obviousness has been established. *In re Best*, 562 F.2d 1252, 1255, 195 USPQ 430, 433 (CCPA 1977). *Titanium Metals Corp. v. Banner*, 778 F.2d 775, 227 USPQ 773 (Fed. Cir. 1985). In the instant case, examiner provided the rationale for the assumption that the claimed viscosity is inherent to the compositions of '782, '095 and '517 i.e., that the compositions of the above patents disclose all of the claimed components, which impart (not a probability) the claimed viscosity. Therefore, the rejection has been maintained.

Applicants traverse the rejections under 35 USC 103(a) as being unpatentable over US patents 5,851,517 ('517) and 5,945,095 ('095).

Applicants argue that neither '517 nor '095 references teach the ability to withstand rubbing under dry or wet conditions, as claimed. It is argued that all the claimed limitations are not taught by the prior art and additionally, one skilled in the art could not have a reasonable expectation of success in achieving the claimed invention

Art Unit: 1615

from starting with the references cited because the references do not teach the claimed ability to withstand rubbing under dry or wet conditions. Applicants' arguments with respect to the teaching of the teachings of '517 and '095 have been addressed in the previous paragraphs. Examiner notes that applicants have not argued the teachings of the fatty esters, fatty alcohols and silicone oils, required by the instant claims.

Accordingly, the argued claim limitation i.e., "ability to withstand rubbing under dry or wet conditions", is a property of the composition and because '517 and '095 teach and suggest all the claimed components, absent showing evidence to the contrary, the compositions of '517 and '095 possess the ability to withstand rubbing under dry or wet conditions.

Applicants traverse the double patenting rejections over the claims of U.S. 5,945,095 ('095).

Applicants argue that the examiner cannot show the claimed percentage of polymer is inherent since this clearly changes with the desired form of the final product and that a support for this position is found in the claims of the '095 used to reject the pending claims, which recite compositions in a form ranging from a liquid to a powder to a stick. It is argued that indeed the claimed mascara of the '095 patent can be in the form of a solid, paste or oily gel, which all clearly cannot have, and thus none inherently can have, the claimed viscosity value. For the same reasons it is argued that the ability to withstand rubbing under dry or wet conditions is not obvious, and certainly not inherent in the claims of the '095 patent and that it is a function of elements neither

Art Unit: 1615

taught nor suggested in the claims of the '095 patent. Applicants' arguments are not persuasive because applicants admit that '095 claims mascara composition, as required by current amendment. Applicants also admit that a mascara composition can be in any form- liquid or paste or powder, which is also claimed by '095 patent. Accordingly, choosing the appropriate amounts of polymer particles dispersed in a fatty phase so as to prepare a solid or a pasty mascara product (see claims 1, 21 and 22 of '095) would have within the scope of a skilled artisan. Instant claims do not recite any more components than claimed by '095 and hence should perform the same function as that claimed. Accordingly, the argument that ability to withstand rubbing under dry or wet conditions is a function of elements is not persuasive.

### ***Conclusion***

**THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of

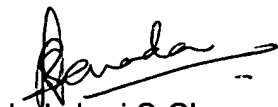
Art Unit: 1615

the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Lakshmi S. Channavajjala whose telephone number is 571-272-0591. The examiner can normally be reached on 9.00 AM -6.30 PM

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael Woodward can be reached on 571-272-8373. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Lakshmi S Channavajjala  
Examiner  
Art Unit 1615

July 21, 2006